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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/015,302	12/12/2001	Matthias Stefan Bierbrauer	DE920000113US1	5653
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25259 7590 03/24/2003

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EXAMINER

FEILD, JOSEPH H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,302

Applicant(s)

BIERBRAUER ET AL.

Examiner

JOSEPH H FEILD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First, it is noted that the primary problem explicitly exists with respect to claims 4, 7, and 8. However, all of the claims are affected because the problem may exist with independent claims 1 and 6 as well, as is explained below.

With respect to dependent claim 4 (and similarly, dependent claim 7 and independent claim 8), the subject matter is confusing because claim 1 (from which claim 4 depends) sets forth the step of "storing a copy of an original document . . . in the repository", and "stripping content from the original document in the document processing system to form a stub document". Since a "copy of an original document" necessarily implies that the entire original document is stored, then there would be no need for "re-inserting the stripped content into the stub document . . . to restore the original document"—the entire document already exists in the repository, so why "re-insert" into the "stub document"? Thus, to remove the confusion, either (1) a "portion of

the original document” would need to be copied and stored in the repository so that reconstruction of the “original document” would be effected by re-inserting the copied portion into the “stub document”, or (2) no “re-insertion” would be necessary—the “stub-document” would merely be used as identification information for retrieving the entire copy of the “original document”. Therefore, if (1) is the case, then each of independent claims 1, 6, and 8 must be amended to reflect that only a “portion of the original document” is copied into the repository. If (2) is the case, then claims 4, 7, and 8 must be amended to remove the “re-insertion”. It is noted that claim 8 recites, “recreating the original document . . . utilizing the stub document and the retrieved document”. Similar rationale applies here as well because there would be no need to “recreate the original document” if it is already stored in its entirety.

With respect to dependent claim 2, the claim sets forth a negative limitation, “wherein said stripping step does not strip descriptive parts of the original document . . .”. Here, it is unclear what is stripped and what is not—what constitutes “descriptive parts”? For example, suppose the first line of text is maintained and the remainder of the document is stripped. In this case, it would be a matter of opinion whether the stripped part constituted “descriptive parts”—key words may have been stripped, which would, for some applications, constitute “descriptive parts”. Overall, the scope of the claim is indefinite.

The remaining dependent claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4, and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Woltz et al (6,216,165-B1).

With respect to independent claims 1, 6, and 8, refer to Woltz's column 6 (lines 24 et seq) and figures 2 and 6. Woltz discloses "handling content off-loading from documents in a document processing system to a repository", "storing a copy of an original document from the document processing system in the repository", and "stripping content from the original document in the document processing system to form a stub document, the stub containing at least information to enable retrieval of the stored document form the repository". Specifically, Woltz discloses:

FIG. 6 illustrates an attachment subroutine which is implemented in the main program body 60 referenced in FIG. 2. An incoming message generated within main program body 60 enters the attachment routine whereupon a copy of the message is archived at step 146. Once archived, decision block 148 determines whether or not the message includes an attachment. If not, the message is transmitted to the pager and e-mail routines at box 50, as described previously. If an attachment is present, the "complete copy" of the message including the attachment is sent to the user's e-mail at box 152. The message then has the attachment stripped off and an appropriate notice is added to the message, indicating that an attachment is in the user's e-mail box at step 154. Subsequently, at step 156, the revised pager message continues through the program.

The attachment routine prevents e-mail messages containing attachments from being forwarded to the user's pager which would otherwise cause problems within the paging company host computer. Furthermore, the recipient of the pager message would be uninformed that an attachment had been removed. In the preferred embodiment of the invention, the archived copy of the message 146 would be available on the host computer for a limited period of time in the event that the e-mail message is received in the user's e-mail box in corrupted form.

Woltz clearly discloses "storing a copy . . ." as archiving a copy of a message, and also as sending a *"complete copy" of the message including the attachment to the user's e-mail at box 152*. He also clearly teaches "stripping content from the original document" to "form a stub document" (*The message then has the attachment stripped off and an appropriate notice is added to the message, indicating that an attachment is in the user's e-mail box at step 154*). Claim 1 is anticipated by Woltz because he teaches storing the entire message in two places—in an archive and at the user's e-mail box. Woltz strips the content "to form a stub document" and adds an indicator (*appropriate notice*) so that the user will know that an attachment exists in the email box. Thus, on the one hand, the information in the "stub document" is not directly used **in Woltz's system** to "retrieve the stored document from the repository". However, the claim language sets forth "the stub containing **at least information to enable retrieval of the stored document from the repository**". Woltz's "stub" includes the message without the attachment plus an indicator that an attachment is stored in the user's e-mail box. Therefore, the stub indeed "contains at least information to enable retrieval of the stored document from the repository". When the user receives the "stub" at his pager, he knows to (for example) open up his e-mail box on his computer, and based on the

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message received on the pager, which would include "at least information to enable retrieval of the stored document from the repository", he would open the e-mail message corresponding to the "stub", and would be able to retrieve the entire document, including the attachment. In addition, at column 6 (lines 39-48), Woltz teaches, *In the preferred embodiment of the invention, the archived copy of the message 146 would be available on the host computer for a limited period of time in the event that the e-mail message is received in the user's e-mail box in corrupted form.* Thus, Woltz explicitly teaches "retrieval of the stored document from the repository".

With further regard to independent claim 8, refer to the rejection under 35 USC §112, 2nd paragraph. As is noted, since a "copy of an original document" necessarily implies that the entire original document is stored, then there would be no need for "recreating the original document". Insofar as the examiner is able to determine, the claim language reads on Woltz's teaching at column 6 (lines 38-48): *In the preferred embodiment of the invention, the archived copy of the message 146 would be available on the host computer for a limited period of time in the event that the e-mail message is received in the user's e-mail box in corrupted form.* In other words, if an e-mail message is received in corrupted form, then the user would retrieve the attachment from the archive by "re-inserting the stripped content into the stub document . . . to restore the original document", thereby resulting in an incorrupt document.

With respect to dependent claim 2, it is evident that Woltz teaches that the stripped message includes enough information for retrieval of the entire document—column 6, lines 34-48.

With respect to dependent claims 4 and 7, refer to the rejection under 35 USC §112, 2nd paragraph. As is noted, since a “copy of an original document” necessarily implies that the entire original document is stored, then there would be no need for “re-inserting the stripped content into the stub document . . . to restore the original document”—the entire document already exists in the repository, so why “re-insert” into the “stub document”? Insofar as the examiner is able to determine, the claim language reads on Woltz’s teaching at column 6 (lines 38-48): *In the preferred embodiment of the invention, the archived copy of the message 146 would be available on the host computer for a limited period of time in the event that the e-mail message is received in the user’s e-mail box in corrupted form.* In other words, if an e-mail message is received in corrupted form, then the user would retrieve the attachment from the archive by “re-inserting the stripped content into the stub document . . . to restore the original document”, thereby resulting in an incorrupt document.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US 2002/0065892-A1, filed 11/30/2000).

With respect to independent claim 1, Malik discloses (see abstract and figures 2-5):

The present invention provides an e-mail communications system that minimizes the number of duplicate copies of common attachment files to e-mail communications that are stored in the mail store of an e-mail server. When the e-mail server receives an e-mail attachment file that is larger than a threshold size, the server performs a database search for another copy of the attachment file in the mail store. If another copy is located, the system creates a pointer in the mail store that associates the located attachment file with the e-mail for the additional recipient(s). Attachment files are deleted only after the recipients of the associated e-mail communications delete each of the respective e-mails.

In figure 2 (23), Malik illustrates a header database (27) and attachment file storage (28). Thus, it is clear that Malik teaches separating the header information from

attachment information, which constitutes "stripping content . . . to form a stub document . . . to enable retrieval of the stored document from the repository". It is noted that while Malik teaches storing an attachment in a separate location from the header information, he fails to explicitly teach "storing a **copy** of an original document . . . in the repository". However, it is noted that claim 1 does not explicitly set forth a step of "generating a copy of an original document". Therefore, the attachment that Malik stores could very well be a "copy of an original document", and the header information "stub document" contains a link to the attachment. It would have been obvious to one of ordinary skill in the art at the time of the invention to "store a copy of an original document" because it was notoriously well known to make copies of documents and transmit them via email at the time of the invention.

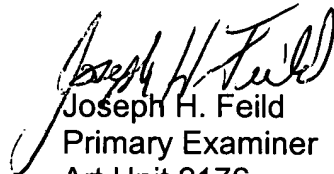
With respect to dependent claims 3 and 5, Malik discloses (abstract, figures 2-5, columns 1-2) creating a link between an e-mail header and attachments if the attachments are larger than a threshold size. Malik's system prevents redundant storage of large file attachments by comparing stored attachment files in the attachment storage. If an attachment file already exists, a link is inserted in the header that points to the location of the file that's already stored. If the attachment file does not yet exist, the file is stored, and a link is inserted in the header file that points to its storage location.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH H FEILD whose telephone number is (703) 305-9792. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HEATHER HERNDON, can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are:

(703) 746-7238	(After Final Communication)
(703) 746-7239	(Official Communication)
(703) 746-7240	(Status Inquiries, Draft Communication).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Joseph H. Feild
Primary Examiner
Art Unit 2176
March 19, 2003